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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT PAPER NUMBER

2652

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,910

Applicant(s)

JUN ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-10,13,14,16-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-10,13,14,16-22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28, 2004 as an after-final amendment has been entered.

Claim Status

Claims 1, 2, 4, 5, 8-10, 13, 14, 16-22 and 25-27 are currently pending.

Claims 3, 6, 7, 11, 12, 15, 23 and 24 have been voluntarily cancelled by the Applicants.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 10, 13, 14, 16, 18-22, 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al. (JP 62-267985).

As per claim 1, 13 and 19, Goto et al. (JP 62-267985) discloses a disk cartridge (12)

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comprising: a case (12) to contain a disk (11); a single member (15, 16) having a pair of transparent windows (13, 14), and attachable to and detachable from the case (12) (e.g., see, *inter alia*, page 6 - last paragraph of English translation of Goto et al. (JP 62-267985)) to allow an external light (from objective lens (4)) to access opposing surfaces of the disk (11) in the case (12) through the single window member.

As per claim 2, wherein the single member (15, 16) is installed so that an outer surface of the single member (15, 16) is inwardly depressed relative to a surface of the case (12) (e.g., see FIG 4, wherein member (14) is slightly inwardly depressed).

As per claim 4 and also claims 10, 14 and 21, wherein the single member (15, 16) is formed of at least one of a glass and acryl (e.g., glass - see page 7, first full paragraph of the English translation of Goto et al. (JP 62-267985)).

As per claims 5 and 27, wherein the single member (15, 16) is installed such that an outer surface of the single member (15, 16) is level with a surface of the case (12). For example, see FIG. 4, wherein the window (17) is level with case surface (12).

As per claim 18 and also claim 22, wherein the single member (15, 16) is expressly installed to the case so as to prevent an inflow of a foreign matter into the case (12) - see English translation of Goto et al. (JP 62-267985).

As per claim 20 and also claim 16, wherein the single (15, 16) has a height such that the outer surface of the single is one of inwardly depressed relative to and at level with a surface of the case (see FIG. 4, as discussed with regard to claims 2 and 5).

With regard to claim 25, a pickup assembly (e.g., including lens (4)) is provided, to emit light onto the disk (11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 17 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over Goto et al. (JP 62-267985).

See the description of Goto et al. (JP 62-267985), *supra*.

With regard to claims 26 (and as well as claims 8, 9 and 17), moreover, given the teachings of Goto et al. (JP 62-267985) as a whole, it would have been obvious to use the cartridge of Goto et al. (JP 62-267985) within an objective lens system such that it meets the open-ended range of values set forth by the variables, including those positively associated with structure.

That is, although Goto et al. (JP 62-267985) remains silent as to the specific relationships set forth in claim 26 or a prescribed dimension as set forth in claims 8, 9 and 17, it is noted that, given the teachings of providing a transparent window within an access window of a disk cartridge such that light for recording/reproducing by an optical pickup lens having a predetermined numerical aperture, is transmissive thereto, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have had the transparent window of Goto et al. (JP 62-267985) so as to interact with recording lens of an optical pickup, to arrive at a width of window within the range set by the formulaic relationship

prescribed in the claims.

The rationale is as follows: one of ordinary skill in the art would have been motivated to have had the transparent window of Goto et al. (JP 62-267985) provided so as to interact with recording lens of an optical pickup, to arrive at a width of window within the range set by the formulaic relationship prescribed in the claims in order to include a window which allows sufficient light to interact with the disk within the cartridge, while minimizing its size such that potential damage or unnecessary window material is thus reduced. No new or unobvious result is seen to be obtained by providing a range or size of window width for the disk cartridge of Goto et al. (JP 62-267985), given the teachings of Goto et al. (JP 62-267985) taken as a whole and the general knowledge available to one having ordinary skill in the art. To arrive at a particular sized window width would have been within the realm of routine optimization/experimentation to thus establish a window width size which performs with a prescribed optical lens,

Moreover, absent a showing of criticality (i.e., unobvious or unexpected results), the relationships set forth in claims 8, 9, 17 and 26, given the disclosure of Goto et al. (JP 62-267985), are considered to be within the level of ordinary skill in the art.

Additionally, the law is replete with cases in which when the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It furthermore has been held in such a situation, the Applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

Response to Arguments

Applicants' arguments as it pertains to the Response filed October 28, 2004 have been fully considered but are deemed nonpersuasive based on the facts and evidence of record, in and/or conjunction with, the level of skill in the art, in view of the teachings of Goto et al. (JP 62-267985).

The Applicants allege that "[i]t is respectfully submitted that a person of ordinary skill in the art would not interpret the pair of window members 13 and 14 of Goto as being a 'single integrated component' or 'single unit' as suggested by the Examiner."

See Applicants' remarks at page 6 of the Response filed on October 28, 2004.

It should now be noted that the Examiner considers the single member to include the integrated elements (13, 14, 15, 16) which are indeed formed as ***one single member*** by being mechanically coupled to each other such that detachment/attachment of the member is a single action (i.e., one does not remove the window element (13) from the frame (15, 16) during detachment, etc). The member is a ***single member*** in that it is one object formed of physically integrated elements, and all parts are required for the single object to function.

Moreover still, the Examiner respectfully disagrees with the Applicants' characterization

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of Goto et al. (JT 62-267985). More concretely, the Examiner steadfastly maintains that Goto et al. (JP 62-267985) does indeed disclose a single transparent window member (13, 14) having top and bottom surfaces, attachable to and detachable from the case (12) as a single unit (e.g., see, *inter alia*, page 6 - last paragraph of English translation of Goto et al. (JP 62-267985)) to allow an external light (from objective lens (4)) to access opposing surfaces of the disk (11) in the case (12) through the single transparent window member.

Although the window member of Goto et al. (JP 62-267985) is made up of individual components prior to final assembly of the window member, once in a finished and completed state, it is indeed a single integrated component.

Again it is uncertain if the Applicants are intending to limit their claim scope to a window member made entirely of, e.g., glass or acryl, wherein the window member as a whole is constituted of such a monolithic composition. Are the Applicants inferring that the window member cannot include any other component or substrate or support or material other than the transparent material? If so, it is a matter of a simple claim modification, e.g., stating that -- *the single window member is a monolithic composition formed entirely of a transparent material* -- or similar claim language should be added to the claims. Is this what the Applicants are alleging that Goto doesn't show? The Examiner agrees that such a limitation would indeed obviate the 35 USC 102 rejection under Goto. However, if Applicants are intending for such claim scope, the Applicants' in the future should reference their specification for such support (or a new issue matter may arise).

The Applicants should bear in mind that the Examiner is charged with interpreting the

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claims in a broad, yet reasonable, manner. Thus, since the Applicants' specification is void of what is meant or defined by a "single" transparent window member, the Examiner has determined the scope to include a window member that is integrated into one sole piece, which includes transparent sections thereof.

For the foregoing reasons, the Examiner maintains a *prima facie* case of anticipation of claims 1, 2, 4, 5, 10, 13, 14, 16, 18-22, 25 and 27 in view of the reference evidence. Based on the totality of the record, including due consideration of Applicants' arguments, the Examiner determines that the preponderance of evidence weighs most heavily in favor of anticipation within the meaning of 35 USC section 102.

Additionally, for the foregoing reasons, the Examiner maintains a *prima facie* case of obviousness of claims 8, 9, 17 and 26, in view of the reference evidence. Based on the totality of the record, including due consideration of Applicants' arguments, the Examiner determines that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103 (a).

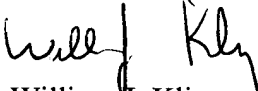
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William V. Klimowicz
Primary Examiner
Art Unit 2652

WJK